



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/565,719

01/25/2006

Ashok M. Adur

1200309N US

7466

35227 7590 05/14/2010

POLYONE CORPORATION
33587 WALKER ROAD
AVON LAKE, OH 44012

EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,719	Applicant(s) ADUR, ASHOK M.	
	Examiner Jeffrey Lenihan	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,10,11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,10,11 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 2/24/2010.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Response to Amendment

4. The amendment to the claims filed on 2/24/2010 does not comply with the requirements of 37 CFR 1.121(c) because claim 15 is improperly labeled with the status identifier "New." Claim 15 was previously introduced in the amendment filed on 6/23/2009, and should therefore be labeled "Previously presented."
5. In the interest of expediting prosecution, the claims have been examiner on the merits; however, any future submissions will be required to comply with the requirements of 37 CFR 1.121(c).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 8, 10, 11, and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 8 has been amended to recite that the cycle time is at least 22% faster than that for an unmodified polymer; this limitation is inherited by all dependent claims. The limitation "at least 22%" reads on any value greater than or equal to 22%; however, the degree by which the cycle time is reduced is only discussed with regards to Examples 10 and 11 of the submitted specification, which are reported to be characterized by cycle times that are 22.0% (Example 11) or 22.6% (Example 10) less than that of unmodified polymers. The original disclosure does not support the broad range "at least 22%" recited in the claims.

Claim Rejections - 35 USC § 103

8. Claims 8, 10, 11, and 13-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Asuka, JP 2000-095902 (of record) in view of Takahashi et al, JP 2001-081236 (of record), Utz et al, US2003/0148056 (of record), and Ogawa et al, WO 02/081570. The examiner notes that Ogawa, US2004/0097650, has been utilized herein as an equivalent English translation of WO 02/081570.

9. The disclosures of Asuka, Takahashi, and Utz are disclosed in the previous Office Actions (for claims 8, 10, 11, 13-15), incorporated herein by reference.

10. Asuka, Takahashi, and Utz are silent regarding the use of injection molding.

11. Ogawa discloses the use of injection molding (for claim 8) (¶0069, 0070) to produce molded articles such as cosmetics containers (¶0120) from a thermoplastic elastomer comprising a blend of a thermoplastic resin, which is most preferably

Art Unit: 1796

polypropylene (¶0007, 0021), and a vinyl aromatic/conjugated diene based copolymer (¶0008).

12. As discussed in the previous Office Action, Asuka discloses that the thermoplastic elastomer of JP2000-095902, comprising a propylene polymer and a styrene/butadiene resin, may be molded into articles such as cosmetics containers. As taught by Ogawa, injection molding was known in the art to be a suitable method for the production of molded cosmetics containers from thermoplastic elastomers having similar composition to that of Asuka. Barring a showing of unexpected results, it therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Asuka by injection molding the thermoplastic elastomer of JP2000-095902, in order to manufacture the molded cosmetics containers recited in the prior art.

13. Regarding the claimed reduction in cycle time: As discussed above and in the previous Office Actions, the prior art renders obvious an injection molded article made from a thermoplastic elastomer, comprising the same components as the thermoplastic elastomer recited in independent claim 8, which has been modified with similar amounts of the same nucleating agents used by applicant. As the prior art article is prepared from a blend comprising the same components combined in similar amounts as the claimed invention, the examiner takes the position that the properties of the prior art article would necessarily be the same as claimed and inherently be not materially different from those of the claimed invention. Applicant is therefore required to provided

evidence demonstrating that the properties used to define the claimed invention are not inherently present in the process rendered obvious by the prior art.

Response to Arguments

14. Applicant's arguments filed 06/23/2009 have been fully considered but they are not persuasive.

15. Applicant argues that Asuka is directed only towards the production of films; this is not persuasive. As cited in the previous Office Action, Asuka states

[Effect of the Invention] Since the composition of the polyolefin-system-resin constituent of this invention is as above-mentioned, Various wrapping, such as a textiles package and food packing; it can use conveniently also as mold-goods materials, such as several kinds of container; electrical machinery parts, such as a medical container, a container for cosmetics, and a food-grade container, a machine part, home mold goods, an agricultural-and-marine-products article, construction materials, and a general-merchandise article.

16. As recited in the above passage, Asuka explicitly envisions the use of the composition of JP2000-095902 for the production of molded articles such as cosmetics containers. The prior art is not restricted only to the production of films as alleged by applicant.

17. Applicant argues that "an abrupt 22% increase in efficiency is entirely unexpected" (remarks page 6, lines 26-27). To rebut a presumption of obviousness, applicant may show "that there are new and unexpected results relative to the prior art;" see *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317,1322,73 USPQ2d 1225, 1228 (Fed. Cir. 2004). As discussed in the previous Office Actions, incorporated herein by reference, applicant has not provided data from even a single comparative example regarding the degree by which cycle time is reduced when a comparable

amount of the prior art nucleating agent is used. In view of applicant's failure to provide any probative comparative data, the examiner maintains the position that applicant has not demonstrated that unexpected results are obtained relative to the prior art.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

/Jeffrey Lenihan/
Examiner, Art Unit 1796

/JL/